

**REMARKS**

Applicant concurrently files herewith an Excess Claim Fee Payment Letter for five (5) excess claims.

Claims 1-30 are all the claims presently pending in the application. Claims 26-30 have been added to claim additional features of the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges that claims 3, 4, 8, 11, 12, and 13 would be allowable if rewritten in independent form. However, Applicant respectfully submits that all of the claims are allowable.

Claims 1, 2, 5, 6, 7, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the article “Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.” in view of the article “Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce,” the article “MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers,” and Galler (“IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?”). Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over “Electronic Transfer Associates,” “Netcentives,” “Microsoft Plaza,” Galler, and further in view of www.PackageNet.com. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over “Electronic Transfer Associates,” “Netcentives,” “Microsoft Plaza,” Galler, and further in view of Shkedy (U.S. Patent No. 6,260,024). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over “Electronic Transfer Associates,” “Netcentives,” “Microsoft Plaza,” Galler, and further in view of official notice. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over “Electronic Transfer Associates,” “Netcentives,” “Microsoft Plaza,” Galler, and further in view of official notice. Claim 14

stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco (“Tend the Store for World Wide Orders”), “Netcentives,” and Galler. Claims 15-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, “Netcentives,” and Galler, and further in view of www.PackageNet.com, and Knowles et al. (U.S. Patent No. 5,689,819). Claims 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, “Netcentives,” Galler, www.PackageNet.com, and Knowles, and further in view of official notice. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over “Electronic Transfer Associates,” in view of Galler, and official notice.

These rejections are respectfully traversed in the following discussion.

## **I. THE CLAIMED INVENTION**

The claimed invention (e.g., as defined by claim 1) is directed to a method of operating a virtual shopping mall by using a computer system. The method includes registering virtual goods information, which corresponds to a seller’s real goods, to the virtual shopping mall after receiving the virtual goods information from the seller, intermediating business between the seller and a buyer on the virtual shopping mall by presenting the virtual goods information to the buyer, setting a delivery path for delivering the real goods from the seller to the buyer in accordance with the buyer’s selection, and establishing trading between the buyer and the seller.

Conventional virtual shopping mall systems for electronically conducting mail order businesses have been developed. Conventional virtual shopping malls require a seller to create a website by himself/herself in order to open a virtual shop. Furthermore, a seller is typically required to communicate with buyers through a network by himself/herself. Finally, a seller is typically required to open and maintain his/her own virtual shop by himself/herself.

The claimed invention (as defined by claim 1), on the other hand, provides a method of operating a virtual shopping mall by using a computer system. The method includes registering virtual goods information, which corresponds to a seller’s real goods, to the virtual shopping mall after receiving the virtual goods information from the seller, intermediating business between the seller and a buyer on the virtual shopping mall by presenting the virtual

goods information to the buyer, setting a delivery path for delivering the real goods from the seller to the buyer in accordance with the buyer's selection, and establishing trading between the buyer and the seller (e.g., see Application at page 3, lines 16-28). This allows the virtual shopping mall to be operated in a computer system without laying the burden for opening a virtual shop on a goods seller in the virtual shopping mall (e.g, see Application at page 3, lines 7-14).

## **II. THE PRIOR ART REJECTIONS**

### **A. The “Electronic Transfer Associates”, “Netcentives”, “Microsoft Plaza” and “Galler” References**

The Examiner alleges that “Electronic Transfer Associates” would have been combined with “Netcentives”, “Microsoft Plaza” and “Galler” to form the claimed invention of claims 1-2 and 6. The Examiner further alleges that “Electronic Transfer Associates”, “Netcentives”, “Microsoft Plaza” and “Galler”, in view of official notice, would have been combined to form the claimed invention of claim 9. Also, the Examiner further alleges that “Electronic Transfer Associates”, “Netcentives”, “Microsoft Plaza” and “Galler”, in view of Official Notice, would have been combined to form the claimed invention of claim 10. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant's invention to set a delivery path for delivering said real goods from said seller to said buyer by said buyer's selection of a terminal base, for the obvious advantage of shipping to locations convenient for the buyers”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant's claimed invention is non-obvious.

Furthermore, contrary to the Examiner's allegations none of these references teaches or suggests their combination.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

More specifically, “Electronic Transfer Associates” is related to “click-on-banners” on third party websites that direct people to a website for purchasing a vendor’s goods associated with the “click-on banner”. “Netcentives” is directed to a “click-rewards” program for offering consumer added value when they shop online. “Microsoft Plaza” is related to a return system for online purchases. Finally, “Galler” is directed to a product delivery service for online purchases and does not even mention a virtual shopping mall. Hence, the cited references are directed to different problems that are completely unrelated to the claimed invention.

In addition, Applicant strongly urges that the Examiner is just “picking and choosing” each element from numerous (e.g., four) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the four publications are clearly unreasonable. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Moreover, contrary to the Examiner’s allegations, none of the cited references, nor any combination thereof, teaches or suggests the method for operating a virtual shopping mall using a computer system as recited in claim 1.

Furthermore, none of the cited references, nor any combination thereof, teaches or suggests that “*the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual*” as recited in new dependent claims 28-30.

In reference to claim 9, the Examiner states that “*Official Notice is taken that it is well known to give volume discounts, and to maintain databases of information. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to set the fee for the virtual shopping mall lower for those sellers whose amount of past trades stored in the seller’s database is large, for the obvious reason of encouraging sellers to do business through the virtual shopping mall.*”

In reference to claim 10, the Examiner states that “*Official Notice is taken that it is well known to inspect goods. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to inspect the goods, for such obvious advantages as assuring that the goods a business is shipping are what was ordered, and of good quality, so as to avoid complaints, lawsuits and the need to replace defective goods, and to maintain a reputation for quality*”.

The Examiner has inappropriately taken Official Notice in this case. Specifically, the Examiner cannot take Official Notice of a system for inspecting goods as well as a system for providing volume discounts in a virtual shopping mall.

According to MPEP §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on Official Notice.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

#### **B. The [www.PackageNet.com](http://www.PackageNet.com) Reference**

The Examiner alleges that [www.PackageNet.com](http://www.PackageNet.com) would have been combined with “Electronic Transfer Associates”, “Netcentives”, “Microsoft Plaza” and “Galler” to form the claimed invention of claim 5. Applicant submits, however, that these references, even if

combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to have the trading include the seller’s setting said terminal base at one of said plurality of real terminal bases to bring in said real goods, for the obvious advantage of enabling said real goods to be conveniently shipped to the buyer”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Furthermore, [www.PackageNet.com](http://www.PackageNet.com) is directed to delivery of online purchases and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

In addition, Applicant strongly urges that the Examiner is just “picking and choosing” each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the five publications are clearly unreasonable. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Moreover, contrary to the Examiner’s allegations none of the cited references, nor any combination thereof, teaches or suggests the method for operating a virtual shopping mall using a computer system as recited in claim 1.

Furthermore, none of the cited references, nor any combination thereof, teaches or suggests that “*the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop*” as recited in new dependent claims 28-30.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

**C. The Shkedy Reference**

The Examiner alleges that Shkedy would have been combined with “Electronic Transfer Associates”, “Netcentives”, “Microsoft Plaza” and “Galler” to form the claimed invention of claim 7. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to present said virtual goods information to said buyer so as to secure anonymity of said seller, for the stated advantage of enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Furthermore, Shkedy is directed to a method and apparatus for providing a system of bi-lateral multi-buyer driven electronic commerce that offers the capability for individual buyers to aggregate their purchase orders into pooled orders and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

On the other hand, all of the above publications merely disclose a general concept of electronic malls, package delivery, and e-commerce services.

Moreover, contrary to the Examiner’s allegations none of the cited references, nor any combination thereof, teach or suggest the method for operating a virtual shopping mall using a computer system as recited in claim 1.

Furthermore, none of the cited references, nor any combination thereof, teach or suggest that “*the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop*” as recited in new dependent claims 28-30.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

#### **D. The Scisco Reference**

The Examiner alleges that Scisco would have been combined with Netcentives and Galler to form the claimed invention of claim 14. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to include a delivery setting section, which achieves a trade on said virtual shopping mall by setting a delivery path for said real goods, from said seller to said buyer, when a trade has been established between said seller and said buyer”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious. Particularly, Scisco states “using only my browser, Clayton and I built a store in one afternoon”. This explicitly encourages a user to use some form of builders to open a shop. This teaches away from the claimed invention because opening a shop on the virtual mall by using a storefront builder lays the burden on the seller.

Furthermore, the cited references are directed to different problems that are completely unrelated to the claimed invention. Additionally, Scisco teaches the seller using a virtual storefront builder. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Moreover, contrary to the Examiner’s allegations none of the cited references, nor any combination thereof, teach or suggest the virtual shopping mall system using a computer

system as recited in claim 14.

Furthermore, none of the cited references, nor any combination thereof, teach or suggest that “*the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop*” as recited in new dependent claims 28-30.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

#### **E. The Knowles Reference**

The Examiner alleges that Knowles would have been combined with Netcentives, Scisco, Galler and www.PackageNet.com to form the claimed invention of claims 15-21. The Examiner further alleges Scisco, Netcentives, Galler and www.PackageNet.com, in view of Official Notice, would have been combined to form the claimed invention of claims 22-24. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to have the virtual shopping mall system comprise a plurality of terminal base units, installed at a plurality of real terminal bases that perform a physical distribution system”.

However, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant’s claimed invention is non-obvious.

Furthermore, Knowles is directed to an Internet based system for tracking objects having URL-encoded bar codes and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

In reference to claim 22, the Examiner states that “*Official Notice is taken that it is well known to lease equipment and thus to manage information about leasing.*”

In reference to claim 23, the Examiner states that “*Official Notice is taken that catalog printing apparatus is well known*”.

In reference to claim 24, the Examiner states that “*Official Notice is taken that searching apparatus in virtual shopping malls is well known*”

We would argue that the Examiner has inappropriately taken Official Notice in this case. Specifically, we would argue that the Examiner can not take Official Notice of an information managing system for leasing equipment, a catalog printing apparatus and a searching apparatus in a virtual shopping mall.

In the present Office Action the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on Official Notice.

Moreover, contrary to the Examiner’s allegations none of the cited references, nor any combination thereof, teaches or suggests the virtual shopping mall system using a computer system as recited in claim 14.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

#### **F. Claim 25**

The Examiner alleges that Electronic Transfer Associates and Galler, in view of Official Notice, would have been combined to form the claimed invention of claim 25. Applicant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Applicant’s invention to achieve a trade on said virtual shopping mall by setting a delivery path of said real goods from said seller to said buyer”.

However, as stated above, Applicant respectfully submits that the large number of references relied upon by the Examiner suggests that Applicant's claimed invention is non-obvious. Furthermore, the cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a *prima facie* case of obviousness.

Additionally, the Examiner states that "*Official Notice is taken that it is well known to use recording media storing programs to instruct computers to carry out methods*". Again, the Examiner has inappropriately taken Official Notice in this case. Specifically, we would argue that the Examiner can not take Official Notice of a recording media storing programs in a virtual shopping mall.

In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on Official Notice.

Moreover, contrary to the Examiner's allegations none of the cited references, nor any combination thereof, teaches or suggests the recording medium as recited in claim 25.

Furthermore, none of the cited references, nor any combination thereof, teach or suggest that "*the virtual shopping mall is operated by the computer without laying the burden for opening a virtual shop on said seller*" as recited in new dependent claim 30.

Therefore, Applicant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore the Examiner is respectfully requested to withdraw these rejections.

### **III. NEW CLAIMS**

New claims 26-30 are added to provide more varied protection for the present invention and to claim additional features of the invention. These claims are independently patentable because of the novel features recited therein.

Applicant respectfully submits that new claim 26-30 are patentable over any combination of the applied references at least for the reasons that are analogous to the reasons

set forth above with respect to claims 1-25.

#### **IV. FORMAL MATTERS AND CONCLUSION**

In response to Examiner's objections, the specification, claims, and drawings have been amended in a manner believed fully responsive to all points raised by the Examiner.

In response to Examiner's objections to the Drawings, Applicant files herewith annotated and replacement sheets for Figures 19 and 65.

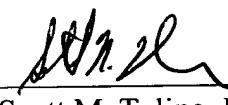
In view of the foregoing, Applicant submits that claims 1-30, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: June 1, 2004

  
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